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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,710	10/24/2001	Gary E. LeGrow	2001US405	2771
25255	7590	08/23/2005	EXAMINER	
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/002,710	LEGROW ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Blessing M. Fubara	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 June 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 and 11-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 and 11-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____



## DETAILED ACTION

Examiner acknowledges receipt of request for reconsideration, remarks and request for extension of time, all filed 06/03/05. Claims 1-9 and 11-19 are pending.

### *Claim Rejections - 35 USC § 103*

1. Claims 1-9 and 11-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over LeGrow et al. (US 5,932,231) in view of JP 012686615 A.

Applicants argue that the references do not provide suggestion or motivation to modify the references to arrive at the claimed invention; the references do not provide motivation to the person of ordinary skill in the art to prepare a composition having trimethylsilylalkylsilsesquioxane in emulsion form; that the teaching or suggestion to make the claimed combination and reasonably expect success to making emulsion from trimethylsilylalkylsilsesquioxane is based on applicants disclosure; that the polymethylsilsesquioxane is insoluble in water, organics and silicones; that the polymethylsilsesquioxane is a gel and has a much higher molecular weight than the trimethylsilylalkylsilsesquioxane and the trimethylsilylalkylsilsesquioxane is compatible with alkylsiloxanes and some organics and that there is no expectation of success in LeGrow and JP 012686615.

2. Applicants' arguments filed 06/03/2005 have been fully considered but they are not persuasive.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the JP reference is relied upon for a disclosure that silsesquioxanes can be used in cosmetic material for skin and hair and medical products for external application in various forms e.g. cream, water in oil type emulsion, oil in water type emulsion, solid material such as lip stick and lotion. The idea is to form an emulsion and polymethylsiloxane is successfully formulated as emulsion by the JP reference. It is thus expected that the alkylsiloxane would form emulsion. The reliance on the JP reference for forming an emulsion from polymethylsiloxane is not an obvious to try scenario but rather a suggestion that silsesquioxane can be formulated as emulsion and the expectation of success is the ability of a larger molecular weight molecule to form an emulsion so that a smaller molecule would reasonable form an emulsion. The abstract of the JP reference does not refer to the polymethylsiloxane as a gel but refers to polymethylsiloxane as a powder which is used in cosmetic material for skin and hair and medical products for external application in

various forms e.g. cream, water in oil type **emulsion**, oil in water type **emulsion**. The polymethylsilsesquioxane of the JP reference is not added to the composition of LeGrow but the person of ordinary skill in the art learning from the JP reference that polymethylsilsesquioxane is formulated as emulsion is motivated to formulate the composition of LeGrow as an emulsion with the expectation that the trimethylsilsesquioxane of LeGrow would be successfully included in emulsions.

No claim is allowed.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

(BP)

Blessing Fubara  
Patent Examiner  
Tech. Center 1600

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600